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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,282	09/30/2002	John F. Braun	F-522	5697
<div>919 7590 10/02/2007 PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000</div>				
			EXAMINER NGUYEN, KIMNHUNG T	
			ART UNIT 2629	PAPER NUMBER
			MAIL DATE 10/02/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/065,282	<b>Applicant(s)</b> BRAUN ET AL.	
	<b>Examiner</b> Kimnhung Nguyen	<b>Art Unit</b> 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on Appeal Brief Filed on 6/19/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-17 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-24 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/8/07 6-7-07</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In view of the Appeal Brief filed on 6/19/07, PROSECUTION IS HEREBY REOPENED. The new ground rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

2. This Application has been examined. The claims 1-3, 5-17 and 21-24 are pending. The examination results are as following.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3,5-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. (US 6,681,045) in view of Kaplan et al. (US 5,813,993).

Regarding claim 1, Lapstun et al. discloses in figure 8, a method for associating metadata with a document having a metadata storage device attached to the document (see computer system having handwritten on a paper associate with identify and coded data, see column 2, lines 57-67) comprising initializing a pointing instrument for capturing pen stroke data (see fig. 38, see col. 19, lines 43-45) using the document (pen 101, figure 8); processing pen stroke data in a normal data capture mode using the document; recognizing a metadata mode (see figure 49); then capturing pen stroke meta data using the pointing instrument using the document(see handwritten on a paper) sending the metadata to a processor; then receiving processed metadata created using the metadata from the processor (see column 2, lines 20-34); and then storing the processed metadata in the metadata storing device that is completely attached to a portion of a surface of the document (see column 36, lines 5-10).

However, Lapstun et al. does not disclose a document having a metadata dynamic read-write storage device, wherein the digital pen is utilized to facilitate storing the processed metadata in the dynamic read-write storage device.

Kaplan et al. discloses in fig. 1, a system comprising a pen recorder<sup>74</sup> and recorder in the store means (82 could be a dynamic read-write storage, because in fig. 1 related to figs. 14-16, with storage means 214, see col. 35, lines 35-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a pen recorder dynamic read-write storage as taught by Kaplan et al. into the document having a metadata storage device attached to the document for producing

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the claimed invention because this would provide the using semiconductor “RAM”, “EEPROM,” or “FLASH” memory, rotating magnetic media, or any other appropriate storage (see col. 35, lines 36-41).

Regarding claim 2, Lapstun et al. discloses that receiving a process metadata command (see figure 38), wherein the pointing instrument is a digital pen (101, figure 8-9, 21), and wherein a user uses the digital pen and the document to generate the process metadata command; and assigning an unique serial number to the metadata (see col. 48, lines 34-42).

Regarding claim 3, Lapstun et al. discloses further, wherein the metadata is pen stroke data (884) captured from a predefined area of the document, wherein the metadata includes a character represent of the captured pen stroke metadata (see fig. 38, see col. 19, lines 43-45) and the storage device is attached to the predefined area of the document (see column 2, lines 57-67)

Regarding claims 5-6, Lapstun et al. discloses further wherein the metadata is pen stroke data captured using the digital pen and document from first subset or all pen strokes made on the document (see column 4, lines 53-57).

Regarding claim 7, Lapstun et al. discloses that wherein the metadata includes biometric data (see figure 21).

Regarding claim 8, Lapstun et al. discloses the method comprising storing an e-copy of the document strokes to the metadata storage (see print a copy of document, see column 25, lines 50-57).

Regarding claim 9, Lapstun et al. discloses the method of claim 2 wherein the metadata storage device comprises an integrated circuit (see col. 42, lines 12-31).

Regarding claim 10, Lapstun et al. discloses that the method of claim 1 wherein the document comprises a piece of paper (see page number, see fig. 56).

Regarding claim 11, Lapstun et al. discloses further wherein the document comprises a spiral bound book (see col. 48, lines 23-24).

Regarding claim 12, Lapstun et al. discloses further comprising: cryptographically processing the metadata using authentication data (see col. 32, lines 40-46, and col. 19, lines 51-53).

Regarding claim 13, Lapstun et al. discloses further comprising: discontinuing capturing metadata data after sufficient data to create a biometric signature is obtained (see fig. 21).

Regarding claim 14, Lapstun et al. discloses further the metadata s a subset of the metadata data (see fig. 38).

Regarding claim 15, Lapstun et al. discloses a method for associating metadata with a document having a metadata storage device comprising: receiving metadata data from a digital pen (see pen 101) using the document; processing the metadata data to determine a biometric signature; sending metadata to the digital pen including the biometric signature (see fig. 21, see col. 2, lines 57-67 and col. 366, lines 5-10); and then storing the processed meta data in the metadata storage device that is attached to the document.

However Lapstun et al. does not disclose a document having a metadata dynamic read-write storage device, and wherein the digital pen is utilized to facilitate storing the processed metadata in the dynamic read-write storage device.

Kaplan et al. discloses in fig. 1, a system comprising a pen recorder<sup>74</sup> and recorder in the store means (82 could be a dynamic read-write storage, because in fig. 1 related to figs. 14-16, see col. 35, lines 35-41) as discussed in claim 1.

Regarding claim 16, Lapstun et al. discloses further comprising cryptographically processing the metadata (see col. 32, lines 40-46).

Regarding claim 17, Lapstun et al. discloses that wherein the metadata includes an e-copy representation of stroke data received from the digital pen (see print a copy of document, see column 25, lines 50-57).

#### ***Allowable Subject Matter***

5. Claims 21-24 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:  
See previous Office Action.

#### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimnhung Nguyen whose telephone number is (571) 272-7698. The examiner can normally be reached on MON-FRI, FROM 8:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimnhung Nguyen

September 25, 2007



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SUPERVISORY PATENT EXAMINER  
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